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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,440	01/03/2002	Cary Fitzgerald	2705-185	6957
20575	7590	02/08/2006	EXAMINER	
MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204			NGUYEN, STEVEN H D	
			ART UNIT	PAPER NUMBER
			2665	

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/038,440	FITZGERALD, CARY	
	Examiner	Art Unit	
	Steven HD Nguyen	2665	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18 and 28-36 is/are allowed.
- 6) ☒ Claim(s) 19-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. Claims 19-27 rejected under 35 U.S.C. 103(a) as being unpatentable over Posthumatu (USP 6,694,012) in view of Dorenbosch (US 20020119795).

Regarding claim 19, Posthuma teaches a device comprising a network interface for coupling to a network (element 70 in fig 1, 70 has to have a network interface to connect to the network through connection 71); and a processor (element 74 in fig. 1) coupled with the network interface, in which the processor is adapted to (fig. 1 and col. 2 lines 34-59, fig. 2 and corresponding description on col. 3 lines 20-49) establish a connection (200); place the connection on hold (202), determine whether there is return speech from the connection that has been placed on hold (204), and if so, withhold transmitting on-hold music/sound through the

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connection (214). Posthuma differs from the claimed invention in that Posthuma does not specifically teach that the connection is a VOIP connection. However, the VOIP telephony is well to be used now. For example, Dorenbosch teaches voice conferencing using voice over IP (VoIP). Therefore, it would have been obvious for one of ordinary skill in the art at the time when the invention was made to include using voice over IP (Void), as taught by Dorenbosch in the assembly of Posthuma in order to facilitate the calls made over IP network, such as the convenient Internet.

Regarding claim 20, Posthuma further teaches that determining whether there is return speech from the connection that has been placed on hold, is performed by interpreting a VAD ON/OFF event (76 and/or 81 in fig. 1 col. 1 lines 31-34 and col. 2 lines 51-52).

Regarding claim 21, Posthuma further teaches determining is performed by monitoring the voice path for return packets (col. 2 lines 51-58)., and analyzing to determine whether the return packets encode speech (col. 2 lines 51-58).

Regarding claim 22, Posthuma further teaches that analyzing is for speech energy that corresponds to speech sustained for a predetermined time minimum (300 and/or 302 in fig. 3., fig. 4, col. 4 Lines 10-33).

Regarding claim 23, Posthuma further teaches that the processor is further adapted to silence-monitor to determine whether prior return speech has discontinued and if so, transmit on-hold music/sound through the connection (col. 4 lines 25-33).

Regarding claim 24, Posthuma further teaches that the silence monitoring is preformed by interpreting a VAD ON/OFF event (col. 4 lines 25-33).

Regarding claim 25, Dorenbosch further teaches that the silence monitoring is performed by interpreting a received SID packet (0024).

Regarding claim 26, Dorenbosch further teaches that the VoIP connection is over a network voice path, and the silence monitoring is performed by monitoring the voip path for return packets, and analyzing to determine whether the return packets encode silence (0024).

Regarding claim 27, Posthuma further teaches that analyzing is for speech energy that corresponds to silence sustained for a predetermined time minimum (300 and/or 302 in fig. 3, fig. 4, col.4, lines 10-33).

Response to Arguments

4. Applicant's arguments filed 11/17/2005 have been fully considered but they are not persuasive.

5. In response to page 10, the applicant states that (1) claim 19 should be allowed for at least similar reasons as claim 1 and (2) Dorenbosch fails to disclose a step of interpreting the silent packet. In reply, with respect to (1), the amended limitation of claim 1 is not amended into the claim 19. Therefore, the teaching of references are performed the claimed invention 19. With respect to (2), Dorenbosch discloses a device receives the silent packet and interprets it in order to determine if it is a silent packet or not, if it is a silent packet, then the device transition into idle mode. Therefore, Dorenbosch discloses a silent monitoring step for monitoring and analyzing the received packet in order to determine if the received packet is a silent packet or not.

6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Posthuma discloses a method and system for establishing a voice connection; put the connection on hold and transmitting the on-hold music to the on-hold device. In response for detecting a return speech from the on hold device, the device that is transmitting on-hold music stops transmission of on-hold music to the on-hold device via a telecommunication network. Dorenbosch discloses a method and system for establishing a teleconference between the devices via internet wherein the internet is a medium that uses to convey the data between the devices. Therefore, it would have been obvious to one of ordinary skill in the art to apply a data network between the devices of Posthuma by converting the input data into a packet. The motivation would have been to reduce the cost of telephone calls.

Allowable Subject Matter

8. Claims 1-18 and 28-36 allowed.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Foladare (USP 6353662) discloses a method and system for determining if a return speech from a on hold device; terminating transmitting a on hold music to the on hold device.

McCormack (US 20020136384) discloses a method and system for providing a music on hold to a device and deactivating it if the device is not on hold.

Jones (USP 6404764) discloses a method and system for providing a music on hold to a device and deactivating it if the device is not on hold.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (571) 272-3159. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571) 272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'Steven HD Nguyen', written over a horizontal line.

Steven HD Nguyen
Primary Examiner
Art Unit 2665
February 6, 2006